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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,168	09/19/2003	Phillip Martin Gibbs	5490-000301	7099

7590 11/08/2006
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EXAMINER

SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,168

Applicant(s)

GIBBS ET AL.

Examiner

Bruce E. Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 35-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 35-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's amendments and arguments filed 9/21/06 have been fully considered. Applicant's argument regarding the rejection in view of Graf (US 2003/0153912) is persuasive. PCT/FR01/02098 (WO 02/00141) was not published in English and, therefore, is not entitled to the earlier priority dates. The declaration filed on 4/3/06 under 37 CFR 1.131 is sufficient to prevent a rejection under 35 U.S.C. 102(a) anticipated by Graf (WO 02/00141).

Regarding the rejection under 35 U.S.C. 102(b) as being clearly anticipated by Germany (DE 9312150, applicant submitted), applicant has amended claims 35 and 39 adding the language wherein the second prosthesis has a bore about a first axis and a portion of the equator of lesser diameter is about the first axis. It is the Examiner's position that applicant's language of being "about" is broad and insufficient to overcome the rejection. "About" does not imply it is the longitudinal axis of the bore or its central axis. Referring to figure 2 of DE 93122150, why is the central axis of 18 not **about** the central axis of broad 13? Second, applicant specifically noted chamfer portion 16 or 43, does this not have an axis about the axis of the 15?

Regarding applicant arguments about the combination rejection of DE 93122150 and Noiles, applicant believes the translation of DE 93122150 teaches, "*a locking collar to restrain luxation is both complicated and requires an additional part,*" thus, teaches away. The Examiner believes applicant is comparing apples and oranges; the locking collar provides a different function than the metal reinforcing band 120 of DE 93122150.

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See applicant cited U.S. 6,093,208, for an example of a locking collar 5. It is the Examiner's position that the reinforcing band 120 of Noiles, figures 26-30, provides a similar/identical function as applicant's element 40.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "bore".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Germany (DE 9312150, applicant submitted). Referring to all figures and embodiments, specifically figure 1 for discussion, DE 93122150 teaches:

39. (Currently Amended) A prosthesis for replacement of an anatomical portion, comprising:

a first prosthesis member 2 including an internal concave portion defining an internal concave diameter; and

a second prosthesis member 14 defining a bore 13 about a first axis having a first diameter substantially equal to said internal concave diameter and defining at least

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a portion 18, 16, 43 of an equator having a second diameter about the first axis less than said first diameter;

wherein said second prosthesis member is adapted to be implanted into said internal concave portion during an operative procedure;

wherein said equator substantially eliminates complete contact of said second prosthesis member with said first prosthesis member.

All other claim limitations are self-evident.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 35-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noiles (4,978,356) in view of Germany (DE 9312150, applicant submitted).

Referring to at least figures 26-30, Noiles teaches a prosthetic joint for replacement of a natural joint to resist dislocation comprising:

a liner 12 including an internal concave portion defining an internal concave diameter, and defining an opening having a passage width smaller than said internal concave diameter;

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a ball portion having a ball diameter substantially equal to said internal concave diameter, and a constraining ring 120 cooperating with said opening,

However, Noiles is silent regarding said ball portion having a cylindrical equator having a diameter to said passage width.

Germany teaches a similar prosthetic joint for replacement of a natural joint to resist dislocation comprising ball 14 having a cylindrical equator 18. It would have been obvious to one having ordinary skill in the art to have utilized the teachings of Germany wherein the ball has a cylindrical equator with the ball of Noiles such that the liner, cup, and retaining ring could be pre-assembled when found desirable by the surgeon and the ball could easily enter the opening passage in an un-anatomical position and lock in an anatomical position within the liner.

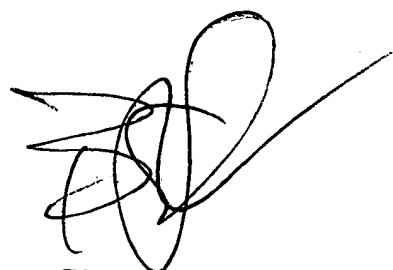
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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BRUCE SNOW
PRIMARY EXAMINER